

## **REMARKS/ARGUMENTS**

### **Drawings**

The documents submitted by the Examining Attorney shows objection to the drawings, related to showing the first and second adapters abutting. In response thereto, the Applicant has amended the claims in question and thereby removing the objection to the drawings. The Applicant therefore submits that amendment to the drawings is no longer required.

### **Claim Objections**

The Examining Attorney has objected to claim 24 stating that there is insufficient antecedent basis for this limitation in the claim. The Applicant submits that claim 24 has been amended to overcome the Examiner's objection.

The Examining Attorney has objected to claim 27 because of informalities, and in response thereto, claim 27 has been amended to overcome the Examiner's objection.

The Applicant respectfully submits that the two claim objections have been removed.

## **Section 112 Rejections**

The Examining Attorney has rejected claims 27 and 28 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended the term "the framework" to now read "a framework", thereby removing the rejection.

## **Obviousness - Section 103(a) Rejection**

The Examiner now submits that the claims are all obvious under section 103(a) based on Allen '224 in view of certain other references, such as Glover '724 for instance. The Applicant requests that the Examiner reconsider this obviousness rejection based on the points made below, and based on the argument accompanying the points.

Firstly the Examiner rejects claims 1, 10, and 15-17 as being unpatentable over Allen in view of Glover. The Applicant respectfully disagrees for at least the reasons set forth below. The adapter the Examiner refers to in Glover would not combine with or work in the Allen invention. It further would not show a passageway between two adapter mount areas on the same adapter, but again it would only possibly show it between two separate adapters mounted.

Again, the Examiner bases the obviousness rejection of all claims on an incorrect premise, namely that the Allen '224 reference discloses all the independent claim elements except the first and the second adapter mount areas. In this case however, **the references combined by the Examiner still**

**do not include all the claim limitations of this application.** Even if Glover is combined, it does not show such an adapter with two adapter areas and through which fiber may pass between the two.

The claims require that the fiber optic adapter holding structures mounted to the tray framework include “a fiber optic cable passageway between the first adapter mount area and the second adapter mount area”, and neither Allen ‘224 nor any of the other references disclose this. At best the Allen reference discloses a plurality of independently mounted adapter holders on a tray, where fiber optic cables happened to be routed between them. The Allen reference **does not disclose**, and does not suggest or teach, that there is a fiber optic holding structure which includes a first adapter mount area and a second adapter mount area, with a fiber optic cable passageway between the two mount areas. Therefore the Examiner has not met the initial burden of a prima facie case of obviousness because there are still elements missing from the combination of references. A quick glance at the difference in the respective densities which are achievable illustrates this point (although aspects of this invention are not limited by a specific density).

The Examiner references column 4, lines 45-51 as showing this, however the rejected claims have this limitation for each of the “adapter holders” – whereas the Allen reference only shows single adapter holders each separately mounted on the tray. The examiner appears to be ignoring the limitation that this passageway is provided on a single adapter holder which holds two

adapters and none of the art shows this. If Allen were combined with Glover it would only result in two double adapter holders being located near two adapter holders, possibly with cable running between the two separate adapter holders (and not between mount areas on the same adapter holder), with the other claim limitations.

Furthermore, there is nothing in the Allen patent reference which teaches or suggests that it can or should be combined with Glover, and it will not work with Glover or combine to identify all the claim limitations at issue.

Still further the proposed modification to the Allen patent renders it unsatisfactory for its intended use and for the combination suggested by the Examiner. It is believed that the Glover reference would not work as asserted with the Allen reference. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The Applicant submits that this deficiency exists at least with respect to independent claims 1, 19 and 23, and consequently all the claims which depend upon claims 1 and 19, which includes claims 2-18 and claims 20-22.

The Examiner has further indicated that with respect to claims 2-4 and 18, they are unpatentable over Allen and Glover as applied to the prior art in the specification. Applicant requests the Examiner reconsider the rejection based on the arguments presented above with respect to the rejection of the independent claims since the independent claims upon which claims 2-4 and 18 are based do not include all the elements of the independent claims, and further based on the argument(s) submitted herein.

The Examiner has further indicated that with respect to claims 2-4, 5, 6 and 18, they are unpatentable over Allen and Glover as applied to other listed art. Applicant requests the Examiner reconsider the rejection based on the arguments presented above with respect to the rejection of the independent claims since the independent claims upon which these rejected dependent claims are based do not include all the elements of the independent claims, and further based on the argument(s) submitted herein.

With respect to claim 24, the Examiner recites Allen, Glover and Koopman as rendering the claim obvious, when combined with what the Examiner labels as disclosing the specific type of adapter, which in claim 24 is an FC type adapter. There is no indication that one of ordinary skill in the art would look to Koopman for such an alignment pin as disclosed in Koopman. Furthermore attempting to take the peg or pin from Koopman and use it combined with Allen or Glover would not work and it does not appear that it would provide a sufficiently accurate alignment guide. Further, there is still nothing in Allen,

Glover or Koopman which suggests or teaches that they should be combined, and there is therefore no prima facie case of obviousness.

With respect to claim 27, the Examiner has referenced Kusuda et al. (6,644,866 B1) alone as rendering claim 27 obvious. The slot 137 identified by the Examiner is not indicated to be an alignment means, but instead is only a slot and physical alignment appears to be required to align the corresponding screw holes and then the screws are inserted and screwed in to fix the position.

Claim 27 on the other

Therefore, Kusuda does not include all the elements and merely calling the slot 137 an alignment means does not make it so and does not indicate it can sufficiently perform that function. There is therefore no basis to assert a prima facie case of obviousness since all the elements are not present and there is no basis to assert that alignment is accomplished by the slot 137, as in this invention.

With respect to claim 28, it requires the fiber optic cable passageway between the first adapter mount area and the second adapter mount area, and for the reasons set forth above with respect to claims 1 and 19, there is no support for this rejection in the record.

Furthermore, there is nothing in the stated references which suggests the desirability of the combination and therefore the Examiner has not met the minimum required showing for *prima facie* obviousness.

In the U.S. Court of Appeals for the Federal Circuit case of *In Re: Lee*, 61 U.S.P.Q. 2d 1430, decided January 18, 2002, the Federal Circuit held:

... Thus, when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The Board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

The examining attorney has therefore failed to meet the requirement to set forth with specificity the general knowledge in the art to enable a finding that the person having ordinary skill in the art would make such combination.

As the PTO recognizes in MPEP 2142:

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process.... The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of non-

obviousness.... The initial evaluation of *prima facie* obviousness thus relieves both the Examiner and Applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention.

MPEP 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re: Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Federal Circuit has several times expressly addressed the issue of how to evaluate an alleged case of *prima facie* obviousness to determine whether it has been properly made. Thus, *In re: Geiger* stated in holding that the PTO “failed to establish a *prima facie* case of obviousness:

Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ADC Hospital Systems, Inc. V. Monteffore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).




## Conclusion

Applicant therefore submits Claims 1-28 are in a position to proceed to allowance.

Respectfully submitted,

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Attachments:      There are none.